

REMARKS

Applicants have carefully reviewed this application in light of the Office Action mailed March 12, 2004. Claims 1-23, 25-39, 41-48, and 50-53 are pending in this application. Claims 1-23, 25-39, 41-48, and 50-53 stand rejected. Applicants previously cancelled Claims 24, 40 and 29. Applicants hereby amend Claim 1, 13, 27, 39 and 48. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §102

Claims 39 and 48 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipate by U.S. Patent 6,266,724 issued to Eliyahou Harari et al. ("Harari et al."). Applicants respectfully traverse and submit that Claims 39 and 48 are patentable over Harari et al.

Harari et al. discloses "peripheral card having a Personal Computer ("PC") card form factor and removably coupled externally to a host system is further partitioned into a mother card portion and a daughter card portion." (Abstract)

Applicants' amended Claim 39 calls for various features including, among others, a "modular bay having a removable-card connector, the modular bay operable to provide a housing for a removable card wherein the modular bay only includes electrical and logical connections between the removable-card connector and a computer system."

Applicants' amended Claim 48 recite various elements including, among other, "installing a removable-card connector in a modular bay such that the removable-card connector is electrically coupled to a computer system, wherein the modular bay only includes electrical and logical connections between the removable card and the computer system."

Harari et al. cannot anticipate Applicants' Claim 39 or 48 because Harari et al. does not teach, suggest or disclose all of the elements recited by Claim 39 or 48. For example, Harari et al. fails to teach, disclose or suggest an a "modular bay having a removable-card connector, the modular bay operable to provide a housing for a removable card wherein the modular bay *only includes electrical and logical connections between the removable-card connector and a computer system,*" as recited by amended Claim 38. (emphasis added) Additionally, Harari et al. fails to teach, disclose or suggest "installing a removable-card

connector in a modular bay such that the removable-card connector is electrically coupled to a computer system, wherein the modular bay *only includes electrical and logical connections between the removable card and the computer system,*" as recited by Claim 48. (emphasis added)

In fact, Herari et al. recites that "[p]artitioning the externally removable PC card into a mother card and daughter card portion allows the functional components of a peripheral implemented on a PC card to be advantageously partitioned." See Col. 3, lines 60-64. However, Applicants assert that the removable card defines the functionality of the system and the modular bay only includes electrical and logical connections between the removable card and the computer system. As such, Applicants respectfully submit that Harari et al cannot anticipate Claim 39 or 48. Therefore, Applicants assert that amended Claims 39 and 48 are patentable over Harari et al.

Rejections under 35 U.S.C. § 103(a)

Claims 41-44 and 50-53 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Harari et al. in view of "Mini PCI Specification" (hereinafter the "Specification"). Applicants respectfully traverse and submit that Claims 41-44 and 50-53 are patentable over Harari et al. in view of Specification.

Claims 41-44 directly or indirectly depend from and provide further patentable limitations to independent Claim 39. Claims 50-53 directly or indirectly depend from and provide further patentable limitations to independent Claim 48. Because Claims 39 and 48 are deemed allowable, Applicants assert that Claims 41-44 and 50-53 are allowable. Thus, Applicants respectfully request the Examiner to reconsider and withdraw the rejections and allow Claims 41-44 and 50-53.

Claims 1-4, 6-18, 20-23, 25-30, 32-38, 41-48, and 50-53 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over the Specification in view of U.S. Patent 5,737,582 issued to Tomoya Fukuzumi (hereinafter "Fukuzumi"). Applicants

respectfully traverse and submit that Claims 1-4, 6-18, 20-23, 25-30, 32-38, 41-48, and 50-53 are patentable over Specification in view of Fukuzumi.

Specification, specifically section 5-6 through 5-12, discloses various mechanical designs, or form factors, for attaching Type 1A, 1B, IIA, IIB, IIIA, IIIB, and III PCB cards to a host system.

Fukuzumi discloses “an IC card and an IC card system that enable a variety of functions to be added to the IC card” vis-à-vis individual key cards. The individual key cards are “detachable from the main body of an IC card” such that addition of a different individual key card changes the function of the IC card. (Abstract)

Applicants’ amended Claim 1 calls for various features including “a modular bay enclosure operable to provide an interconnect for a mini-Peripheral Component Interconnect card, which defines a functionality of the modular bay enclosure, to a computer system, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect card and the computer system.”

Applicants’ amended Claim 13 recites a computer system comprising, among other features, a “modular bay enclosure containing said mini-Peripheral Component Interconnect connector, the modular bay enclosure operable to provide a housing for connecting the mini-Peripheral Component Interconnect card to the computer system, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect connector and the computer system.”

Applicants’ amended Claim 27 recites a method including “installing a mini-Peripheral Component Interconnect connector into a modular bay enclosure such that the modular bay enclosure operable to electrically couple the mini-Peripheral Component Interconnect connector to a computer system via an input/output bus, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect connector and the computer system.”

Applicants’ amended Claim 39 calls for various features including “a modular bay having a removable-card connector, the modular bay operable to provide a housing for a removable card wherein the modular bay only includes electrical and logical connections between the removable-card connector and a computer system.”

Applicants' amended Claim 48 recites a method including "installing a removable-card connector in a modular bay such that the removable-card connector is electrically coupled to a computer system, wherein the modular bay only includes electrical and logical connections between the removable card and the computer system."

Neither Specification nor Fukuzumi make obvious Claims 1-4, 6-18, 20-30, 32-39, 41-48, and 50-53, as amended, of Applicants' invention, because there is no motivation to combine Specification with Fukuzumi. For instance, even if Specification and Fukuzumi were to be combined, the combination would not disclose or suggest a "modular bay enclosure operable to provide an interconnect for a mini-Peripheral Component Interconnect card, which defines a functionality of the modular bay enclosure, to a computer system, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect card and the computer system" as recited by amended Claim 1. The "modular bay enclosure" of Applicants' invention provides a housing for the mini-PCI card and only includes electrical and logical connections between the mini-PCI cards and the computer system such that the cards define the functionality of the enclosure. Neither Specification nor Fukuzumi alone or in combination suggest Applicants' invention.

Additionally, Specification and Fukuzumi do not disclose, teach or suggest a "modular bay enclosure containing said mini-Peripheral Component Interconnect connector, the modular bay enclosure operable to provide a housing for connecting the mini-Peripheral Component Interconnect card to the computer system, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect connector and the computer system," as recited by amended Claim 13. Specification and Fukuzumi do not disclose, teach or suggest "installing a mini-Peripheral Component Interconnect connector into a modular bay enclosure such that the modular bay enclosure operable to electrically couple the mini-Peripheral Component Interconnect connector to a computer system via an input/output bus, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect connector and the computer system," as recited by amended Claim 27.

Further, Specification and Fukuzumi do not disclose, teach or suggest a "modular bay having a removable-card connector, the modular bay operable to provide a housing for a

removable card wherein the modular bay only includes electrical and logical connections between the removable-card connector and a computer system,” as recited by amended Claim 39. Lastly, Specification and Fukuzumi do not disclose, teach or suggest “installing a removable-card connector in a modular bay such that the removable-card connector is electrically coupled to a computer system, wherein the modular bay only includes electrical and logical connections between the removable card and the computer system,” as recited by amended Claim 13.

Applicants disagree with the Examiner’s statement that “the functional portion *gives* the IC card a *distinguishing characteristic*.” (Paper No. 20, page 13) (emphasis in original) Applicants are confused as to this statement because Fukuzumi fails to state that the IC card receives a “distinguishing characteristic” from the IC card and Applicants do not believe that it is necessarily implied by any portion of the specification of Fukuzumi. As such, Applicants respectfully request that the Examiner indicate the location of the “distinguishing characteristic” in the specification of Fukuzumi.

Applicants traverse the Examiner’s assertion that the modular bay enclosure, of Applicants’ invention is similar to “a modular IC card” of Fukuzumi. The modular IC card of Fukuzumi is an IC card having a function. A portion of the function of the IC card can be changed or added to with the subcard (Fukuzumi col. 2, ln. 7-14). In contrast, the mini-PCI card of Applicants’ invention defines the functionality. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the rejection to and allow Claims 1, 13, 27, 39, and 48, as amended.

Claims 2-4 and 6-12 depend from and provide further patentable limitations to amended Claim 1. Claims 14-18 and 20-26 depend from and provide further patentable limitations to amended Claim 13. Claims 28-30 and 32-38 depend from and provide further patentable limitations to amended Claim 27. Claims 41-47 depend from and provide further patentable limitations to amended Claim 39. Claims 50-53 depend from and provide further patentable limitations to amended Claim 48. Because claims 1, 13, 27, 39, and 48, as amended, are deemed allowable, Claims 2-4, 6-12, 14-18, 20-26, 28-30, 32-38, 41-47, and 50-53 are allowable. Therefore, Applicants respectfully request the Examiner to reexamine, reconsider, withdraw the rejection to and allow Claims 1-4, 6-18, 20-30, 32-39, 41-48, and 50-53, as amended.

Claims 5, 19, and 31 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Specification in view of Fukuzumi, and further in view of U.S. Patent 6,067,583 issued to Timothy G. Gilbert (hereinafter "Gilbert"). Applicants respectfully traverse and submit that Claims 5, 19, and 31 are patentable over Specification, Fukuzumi and Gilbert.

Claim 5 depends from and provides further patentable limitations to amended Claim 1. Claim 19 depends from and provides further patentable limitations to amended Claim 13. Claim 31 depends from and provides further patentable limitations to amended Claim 27. Because Claims 1, 13, and 27, as amended, are deemed allowable, Claims 5, 19, and 31 are allowable. Therefore, Applicants respectfully request the Examiner to reexamine, reconsider, withdraw the rejection to and allow Claims 5, 19 and 31.

Claims 1-4, 6-18, 20-23, 25-30, 32-38, 41-48, and 50-53 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over the Specification in view of Harari et al. Applicants respectfully traverse and submit that Claims 1-4, 6-18, 20-23, 25-30, 32-38, 41-48, and 50-53 are patentable over Specification in view of Harari et al.

Specification, specifically section 5-6 through 5-12, discloses various mechanical designs, or form factors, for attaching Type 1A, 1B, IIA, IIB, IIIA, IIIB, and III PCB cards to a host system.

Harari et al. discloses "peripheral card having a Personal Computer ("PC") card form factor and removably coupled externally to a host system is further partitioned into a mother card portion and a daughter card portion." (Abstract)

Applicants' amended Claim 1 calls for various features including "a modular bay enclosure operable to provide an interconnect for a mini-Peripheral Component Interconnect card, which defines a functionality of the modular bay enclosure, to a computer system, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect card and the computer system."

Applicants' amended Claim 13 recites a computer system comprising, among other features, a "modular bay enclosure containing said mini-Peripheral Component Interconnect connector, the modular bay enclosure operable to provide a housing for connecting the mini-Peripheral Component Interconnect card to the computer system, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect connector and the computer system."

Applicants' amended Claim 27 recites a method including "installing a mini-Peripheral Component Interconnect connector into a modular bay enclosure such that the modular bay enclosure operable to electrically couple the mini-Peripheral Component Interconnect connector to a computer system via an input/output bus, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect connector and the computer system."

Applicants' amended Claim 39 calls for various features including "a modular bay having a removable-card connector, the modular bay operable to provide a housing for a removable card wherein the modular bay only includes electrical and logical connections between the removable-card connector and a computer system."

Applicants' amended Claim 48 recites a method including "installing a removable-card connector in a modular bay such that the removable-card connector is electrically coupled to a computer system, wherein the modular bay only includes electrical and logical connections between the removable card and the computer system."

Neither Specification nor Harari et al make obvious Claims 1-4, 6-18, 20-30, 32-39, 41-48, and 50-53, as amended, of Applicants' invention, because there is no motivation to combine Specification with Harari et al. For instance, even if Specification and Harari et al were to be combined, the combination would not disclose or suggest a "modular bay enclosure operable to provide an interconnect for a mini-Peripheral Component Interconnect card, which defines a functionality of the modular bay enclosure, to a computer system, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect card and the computer system" as recited by amended Claim 1. The "modular bay enclosure" of Applicants' invention provides a housing for the mini-PCI card and only includes electrical and logical connections between the mini-PCI cards and the computer system such that the cards define the functionality of the

enclosure. Neither Specification nor Harari et al alone or in combination suggest Applicants' invention.

Additionally, Specification and Harari et al do not disclose, teach or suggest a "modular bay enclosure containing said mini-Peripheral Component Interconnect connector, the modular bay enclosure operable to provide a housing for connecting the mini-Peripheral Component Interconnect card to the computer system, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect connector and the computer system," as recited by amended Claim 13. Specification and Harari et al do not disclose, teach or suggest "installing a mini-Peripheral Component Interconnect connector into a modular bay enclosure such that the modular bay enclosure operable to electrically couple the mini-Peripheral Component Interconnect connector to a computer system via an input/output bus, wherein the modular bay enclosure only includes electrical and logical connections between the mini-Peripheral Component Interconnect connector and the computer system," as recited by amended Claim 27.

Further, Specification and Harari et al do not disclose, teach or suggest a "modular bay having a removable-card connector, the modular bay operable to provide a housing for a removable card wherein the modular bay only includes electrical and logical connections between the removable-card connector and a computer system," as recited by amended Claim 39. Lastly, Specification and Harari et al do not disclose, teach or suggest "installing a removable-card connector in a modular bay such that the removable-card connector is electrically coupled to a computer system, wherein the modular bay only includes electrical and logical connections between the removable card and the computer system," as recited by amended Claim 13. Because neither Specification nor Harari et al, alone or in combination, make obvious Claims 1, 13, 27, 39 or 48, as amended, of Applicants' invention, Applicants asserts that amended Claims 1, 13, 27, 39 and 48 are patentable over Specification in view of Harari et al. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the rejection to and allow Claims 1, 13, 27, 39, and 48, as amended.

Claims 2-4 and 6-12 depend from and provide further patentable limitations to amended Claim 1. Claims 14-18 and 20-26 depend from and provide further patentable limitations to amended Claim 13. Claims 28-30 and 32-38 depend from and provide further patentable limitations to amended Claim 27. Claims 41-47 depend from and provide further

patentable limitations to amended Claim 39. Claims 50-53 depend from and provide further patentable limitations to amended Claim 48. Because claims 1, 13, 27, 39, and 48, as amended, are deemed allowable, Claims 2-4, 6-12, 14-18, 20-26, 28-30, 32-38, 41-47, and 50-53 are allowable. Therefore, Applicants respectfully request the Examiner to reexamine, reconsider, withdraw the rejection to and allow Claims 1-4, 6-18, 20-30, 32-39, 41-48, and 50-53, as amended.

Claims 5, 19, and 31 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Specification in view of Harari et al., and further in view of Gilbert. Applicants respectfully traverse and submit that Claims 5, 19, and 31 are patentable over Specification, Harari et al. and Gilbert.

Claim 5 depends from and provides further patentable limitations to amended Claim 1. Claim 19 depends from and provides further patentable limitations to amended Claim 13. Claim 31 depends from and provides further patentable limitations to amended Claim 27. Because Claims 1, 13, and 27, as amended, are deemed allowable, Claims 5, 19, and 31 are allowable. Therefore, Applicants respectfully request the Examiner to reexamine, reconsider, withdraw the rejection to and allow Claims 5, 19 and 31.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the rejections and allowance of Claims 1-23, 25-39, 41-48, and 50-53, as amended.

Applicants do not believe any fee is due, however, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 02-0383 of Baker Botts L.L.P. in order to effectuate this filing.

Respectfully submitted,

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